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REMARKS

Claims 1-11 are pending in the present application. Claim 4 has been amended herewith to correct a typographical error. Reconsideration of the claims is respectfully requested.

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification.

I. Objection to Specification

The Examiner objected to the Specification, stating that in the Abstract, on line 32, "is set" should be "are set" and on line 40, "generate" should be "generating". Applicants have amended the Abstract herein, in accordance with the Examiner's suggestions. Therefore, the objection to the specification has been overcome.

II. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 1, 3, 7 and 9 under 35 U.S.C. § 102(a) as being anticipated by Ferrel et al. (USPN 5,860,073). This rejection is respectfully traversed.

For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicants will now show that every element of Claims 1, 3, 7 and 9 are not identically shown in a single reference, and thus the rejection of such claims under 35 U.S.C. § 102(a) is in error.

With respect to Claim 1 (and similarly for Claim 7), Applicants show that the cited reference does not teach the claimed step recited in step (d) of "*inspecting a plurality of display conditions* respectively related to each of said pieces of content specifying information *to determine whether each display condition has a content to be embedded in said page template*". As can be seen, this step recites not only 'pieces of content specifying information' but in addition recites 'a plurality of display conditions' that are respectively related to each of the pieces of content specifying information. In rejecting this step of Claim 1, the Examiner states that the cited reference teaches "pieces of information are processed with respect to the style sheet". The Examiner has already

equated the Ferrel style sheet with the claimed page template. Thus, in rejecting step (d), the Examiner has merely alleged a teaching of a style sheet and pieces of information are processed with respect to the style sheet. However, step (d) of Claim 1 goes further, and expressly recites - in addition to a style sheet/template and pieces of information – a plurality of *display conditions that are inspected to determine whether each display condition has a content to be embedded in said page template*. The cited reference does not teach, nor has the Examiner alleged any teaching of, such inspection and embedded operations. This conditional embedding into the page template advantageously provides the ability to dynamically change content to be embedded therein without manual editing an HTML file or correcting a server program such as CGI. The cited reference does not teach this claimed feature or its resulting advantage. Thus, Claim 1 (and similarly for Claim 7) is shown to not be anticipated by the cited reference.

With respect to Claim 3 (and similarly for Claim 9), Applicants traverse for similar reasons given above regarding Claim 1, step (d), and show that the cited reference does not teach the claimed step of “*inspecting a plurality of display conditions respectively related to each of said pieces of content specifying information to determine whether each display condition has a content to be embedded in said page template*”. Thus, Claim 3 (and similarly for Claim 9) is shown to not be anticipated by the cited reference.

Therefore, the rejection of Claims 1, 3, 7 and 9 under 35 U.S.C. § 102 has been overcome.

III. 35 U.S.C. § 103, Obviousness

A. The Examiner rejected Claims 2 and 8 under 35 U.S.C. § 103 as being unpatentable over Ferrel, and further in view of Davis et al. (USPN 5,796,952). This rejection is respectfully traversed.

To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). Applicants will not show that *all* of the claim limitations are not taught or suggested by the cited references.

With respect to Claim 2 (and similarly for Claim 8), Applicants show that none of the cited references teach or suggest the claimed step of "*inspecting a plurality of schedule conditions respectively related to each of said banner beans to determine whether each schedule condition is a bean including a banner to be embedded in the page template*". In rejecting Claim 2, the Examiner states that Ferrel teaches that pieces of information are processed with respect to the style sheet, which must inherently manage schedule issues for content in order to successfully display disparate pieces of content concurrently. Applicants show error in such inherency assertion. "To establish inherency," the Federal Circuit recently stated, "the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999); see also *Continental Can Co. U.S.A., Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Such inherency may not be established by "probabilities or possibilities." *Continental Can*, 948 F.2d at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (C.C.P.A. 1981)). The Examiner states schedule conditions are inherent in order to successfully display disparate pieces of content concurrently. Applicants show that this is a mere possibility, and is not necessarily required. Concurrent display of disparate content may be accomplished by use of a display buffer (memory), where contents of the memory are read to generate a composite screen image. The disparate items that are displayed in this composite screen image could well be placed in this display buffer memory in the order to which they are received and processed – i.e. without regard to any type of schedule or schedule conditions. Thus, the fact that disparate content is concurrently displayed, as asserted by the Examiner, does not clearly establish the use of scheduling or scheduling conditions in the teachings of the cited references. Accordingly, such scheduling is a mere probability of possibility, and thus is not inherent (inherency requires that *the extrinsic evidence must make clear* that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill). Therefore, the Examiner's assertion regarding inherency of such scheduling conditions is shown to be in error. In addition, as *all* the claimed elements are not taught or suggested by the cited references, it

is shown that Claim 2 (and similarly for Claim 8) is not obvious in view of the cited references.

Further with respect to this step (d) of Claim 2, none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion, determining whether something should be *embedded in the page template* (which the Examiner equates to Ferre's style sheet). Ferrel merely teaches use of a style sheet when rendering content, but makes no mention of conditionally embedding information into such style sheet. Nor does the cited Davis reference overcome this deficiency. This reference mentions use of a Java applet, which is a combination ad banner and tracking program (Col. 15, lines 19-20). There is no mention of any type of conditional embedding into a page template or style sheet, and it similarly follows that there is no teaching or suggestion that such (missing) conditional embedding is based upon schedule conditions related to banner beans. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is simply no suggestion in the cited references to modify the teachings therein in accordance with claimed step (d) of Claim 2. Thus, Claim 2 (and similarly for Claim 8) is further shown to not be obvious in view of the cited references. This conditional embedding into the page template advantageously provides the ability to dynamically change content to be embedded therein without manual editing an HTML file or correcting a server program such as CGI.

Further with respect to Claim 2 (and similarly for Claim 8), Applicants show that none of the cited references teach or suggest the specific step recited in step (e) of "obtaining display-image specifying information and link-destination-URL specifying information from a banner bean judged as a bean including a banner to be embedded in the page template". As can be seen, such claim recites that two things are obtained from a banner bean – display-image specifying information *and* link-destination-URL specifying information. This claimed feature advantageously provides that both image data for forming an object to be embedded in the banner bean, as well as information for linking link-destination URL information and output message information, are included in the banner bean. The Examiner has merely alleged that Davis describes a banner bean

(generally). The Examiner has not alleged a specific teaching or suggestion, nor do any of the cited references actually teach or suggest, obtaining two types of information (display-image specifying information and link-destination-URL specifying information) from a banner bean. Thus, a *prima facie* case of obviousness has not been made with respect to Claim 2 (and similarly for Claim 8), as all the claim limitations are not taught or suggested by the cited references.

Therefore, the rejection of Claims 2 and 8 under 35 U.S.C. § 103 has been overcome for numerous reasons as described above.

B. The Examiner rejected Claims 4 and 10 under 35 U.S.C. § 103 as being unpatentable over Ferrel, and further in view of Beauchamp et al. (USPN 6,621,505). This rejection is respectfully traversed.

Regarding Claim 4, Applicants show that none of the cited references teach or suggest the step recited in step (c) of "setting schedule information serving as a condition for contents to be displayed in said display area to said part bean". The Examiner acknowledges that the cited Ferrel reference does not teach any of steps (a)-(d) recited in Claim 4, but cites Beauchamp as teaching use of a template that operates in conjunction with a JavaBean (citing Beauchamp Col. 14, lines 45-47), and a communication servlet that regulates HTML output (citing Beauchamp Col. 19, lines 48-67). The Examiner then opines that the servlet operating in conjunction with a page-template bean *must* obtain content from a part bean to operate successfully, along with setting schedule information for the part. The Examiner appears to be stating that setting scheduling information for the part is inherent, as no specific citation to such a teaching is given. Applicants have previously shown, in the discussion of Claim 2, that scheduling information is not an inherent characteristic. Applicants urge, with respect to Claim 4, that none of the cited references teach or suggest any type of schedule information that serves as a condition for contents to be displayed. Thus, as all the claimed elements are not taught or suggested by the cited reference, Claim 4 is shown to not be obvious in view of the cited references.

Further with respect to Claim 4, Applicants show that none of the cited references teach or suggest the claimed feature of "defining a page-template bean for holding as a property information for specifying an HTML file, including a Servlet defining section

containing display-area specifying information as a parameter". As can be seen, such claim recites that the page-template includes information for specifying a servlet. As described in Applicant's Abstract (and elsewhere), this claimed feature advantageously provides an ability to dynamically change content to be embedded in a page template or layout, in that a page template is defined with a servlet that specifies a display area and a display attribute for controlling displays as parameters. None of the cited references teach or suggest this claimed feature or its resulting advantages. In rejecting Claim 4, the Examiner merely states that Beauchamp teaches a communication servlet, and opines that the servlet operating in conjunction with a page-template bean *must* obtain content from a part bean to operate successfully. Applicants show that the claim does not merely recite an operation (obtaining content) between a servlet and a bean, but rather that the page-template itself contains a reference to a servlet having particular characteristics. This is not taught or suggested, nor has the Examiner alleged any teaching or suggestion, in either cited reference. Therefore, the Examiner has failed to establish a *prima facie* showing of obviousness with respect to Claim 4.

Regarding Claim 10, Applicants show that none of the cited references teach or suggest "an arrangement object for holding said part bean, the display-area specifying information, and information serving as a condition for said part bean to be displayed in said display area by relating said part bean, the display-area specifying information, and said condition-serving information with each other". Thus, the claimed arrangement object is shown to hold at least three items: (1) the part bean, (2) the display-area specifying information, and (3) information serving as a condition for said bean to be displayed in the display area. None of the cited references teach such an object holding those three expressly recited items. Nor has the Examiner alleged any teaching or suggestion of such an object holding these three items. Thus, the Examiner has failed to establish a *prima facie* showing of obviousness¹ with respect to Claim 10, and the burden

¹ To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

has not shifted to Applicants to rebut obviousness². As all other statutory requirements have been met, Applicants are entitled to a patent at least with respect to Claim 10³.

Applicants further traverse the rejection of Claim 10 for similar reasons to those discussed above in reference to Claim 4 regarding the claimed template servlet parameter. Thus, Claim 10 is further shown to not be obvious in view of the cited references.

Therefore, the rejection of Claims 4 and 10 under 35 U.S.C. § 103 has been overcome.

C. The Examiner rejected Claim 5 under 35 U.S.C. § 103 as being unpatentable over Ferrel. This rejection is respectfully traversed.

With respect to Claim 5, Applicants show that the cited reference does not teach or suggest "a schedule engine for inspecting a plurality of display conditions respectively related to each of said plurality of pieces of content specifying information to determine whether each display condition has a content to be embedded in said page template". The Examiner expressly acknowledges that Ferrel fails to disclose use of a schedule engine. However, states the Examiner, it was notoriously well known that schedule engines may be used to arrange items which must operate concurrently in order [to] prevent conflicts between disparate elements of complex systems. Applicants show error in this "well-known" basis for rejection being used by the Examiner. As stated by the Federal Circuit, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior

² In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

³ In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerisonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). The Examiner's comments regarding well-known schedule engines is thus shown to be an insufficient basis for making an obviousness rejection.

Further, although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is simply no suggestion or motivation in the cited reference to modify the teachings contained therein to include a schedule engine that inspects a plurality of display conditions respectively related to each of said plurality of pieces of content specifying information to determine whether each display condition has a content to be embedded in said page template. Thus, Claim 5 is shown to have been erroneously rejected as there are missing claimed elements not taught or suggested by the cited reference.

Therefore, the rejection of Claim 5 under 35 U.S.C. § 103 has been overcome.

D. The Examiner rejected Claim 6 under 35 U.S.C. § 103 as being unpatentable over Ferrel, in view of Beauchamp et al. (USPN 6,621,505), and further in view of Rogers et al. (USPN 6,621,505). This rejection is respectfully traversed.

With respect to Claim 6, Applicants show that none of the cited references teach or suggest the claimed feature of "an arrangement rule DB for storing an arrangement object for holding said part bean, the display-area specifying information, and schedule information serving as a condition for said part bean to be displayed in said display area by relating said part bean, the display-area specifying information, and said schedule information with each other". Thus, the claimed arrangement object is shown to hold at least three items: (1) the part bean, (2) the display-area specifying information, and (3) schedule information serving as a condition for said part bean to be displayed in the

display area. None of the cited references teach such an object holding those three expressly recited items. Nor has the Examiner alleged any teaching or suggestion of such an object holding these three items. Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 6, and the burden has not shifted to Applicants to rebut obviousness. As all other statutory requirements have been met, Applicants are entitled to a patent at least with respect to Claim 6.

Applicants further traverse the rejection of Claim 6 for similar reasons to those discussed above in reference to Claim 4 regarding the claimed template servlet parameter. Thus, Claim 6 is further shown to not be obvious in view of the cited references.

Therefore, the rejection of Claim 6 under 35 U.S.C. § 103 has been overcome.

E. The Examiner rejected Claim 11 under 35 U.S.C. § 103 as being unpatentable over Davis, in view of Ferrel, and further in view of Beauchamp et al. This rejection is respectfully traversed.

With respect to Claim 11, Applicants show that none of the cited references teach or suggest "a banner bean holding banner-display-image specifying information for specifying a display image of a banner displayed in a display area and banner-link-destination-URL specifying information for specifying a link destination URL of said banner as properties". As can be seen, the recited banner bean holds at least two items: (1) banner-display-image specifying information for specifying a display image of a banner displayed in a display area, and (2) banner-link-destination-URL specifying information for specifying a link destination URL of said banner as properties. None of the cited references teach a banner bean holding these two types of information. In rejecting Claim 11, the Examiner states that Davis describes a banner bean that is easily configurable and robust, which reads on the claimed banner bean. Applicants respond by showing that a general statement that a bean is easily configurable and robust does not teach or suggest the specific claimed features of the banner bean – that it holds both (1) banner-display-image specifying information for specifying a display image of a banner displayed in a display area, and (2) banner-link-destination-URL specifying information for specifying a link destination URL of said banner as properties. As none of the cited

references teach or suggest such banner bean characteristics or features, it is shown that Claim 11 is not obvious in view of the cited references, as there is at least one missing claimed element not taught or suggested by the cited reference.

Further with respect to Claim 11, Applicants show that none of the cited references teach or suggest "an arrangement object for holding said banner bean, the display-area specifying information, and schedule information serving as a condition for said banner to be displayed in a display area by relating said banner bean, the display-area specifying information, and said schedule information with each other". None of the cited references teach such an object holding those three expressly recited items. Nor has the Examiner alleged any teaching or suggestion of such an object holding these three items. Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 11, and the burden has not shifted to Applicants to rebut obviousness. As all other statutory requirements have been met, Applicants are entitled to a patent at least with respect to Claim 11.

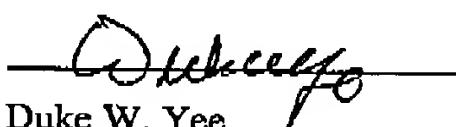
Therefore, the rejection of Claim 11 under 35 U.S.C. § 103 has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 4/23/04

Respectfully submitted,


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